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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,693	08/09/2001	Robert Booker	PA-5265-RFB	4288
7590	10/19/2004		EXAMINER	
BRINKS HOFER GILSON & LIONE ONE INDIANA SQUARE, STE 1600 INDIANAPOLIS, IN 46204			JAWORSKI, FRANCIS J	
			ART UNIT	PAPER NUMBER
			3737	
DATE MAILED: 10/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

b/c

Office Action Summary	Application No.	Applicant(s)	
	09/925,693	BOOKER ET AL.	
	Examiner	Art Unit	
	Jaworski Francis J.	3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 May 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18, 20 - 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 16-18 and 20-23 is/are allowed.
- 6) Claim(s) 1-15, 24-47 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-9, 11, 13, 26 and 31-32⁴⁷, as amended are rejected under 35 U.S.C. 103(a) as being unpatentable over Drost et al (US6036645, of record) in view of Chandler et al (US6093150, of record).

The former is directed to structure and method for use of a transducer head 24 which includes an ultrasound bloodflow sensor and its connecting wires as well as a distal shapable portion 16 such as a steel wire which is sized and dimensioned to be wrapped around small vessels intra-operatively during surgery, being malleable enough so a surgeon can bendably position it under finger pressure yet retaining its position once set. Drost et al does not teach that the shapeable portion 16 may extend backwards to the handle 12.,

However it would have been obvious in view of Chandler et al col. 7 lines 28 – 64 and col. 9 line 37 – col. 11 line 13 to fashion a malleable portion such as a wire 9 all the way back from the probe neck 2 to the handle portion (col. 10 line 8) which is not shown, since this structure adaptation would allow a z-shaped offset to be customized for each patient and if the malleable form wire and connection wires are flattened this

further assists in the ergonomics needed for manipulation when placing the probe into areas difficult to access. (Claims 1, 26).

Arguments regarding the dependent claims or including the cannula feature (Claims 2, 31) are otherwise as set forth against these claims in the Office action mailed March 1, 2004.

Claims 1,4 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drost et al as applied against claim 1 above and claim 7 in the prior Office action, further in view of Gade (US4945896, of record), since as noted in the prior Office action the latter extends use of bloodflow sensors to neurosurgical brain procedures and uses a sensor construct wherein the probe sensor at least partly resides within a malleable probe portion i.e. blade 18 in order to provide a smooth instrument contour for presentation against tissue.

Claims 4-6, 29-30 and 33-40 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drost et al in view of Chandler et al as applied to claims 1-26 above, and further in view of Yock et al as the latter was applied in the prior Office action including the grouping of Chandler et al against claim 44 in the prior Office action...

Claims 10 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drost et al in view of Chandler et al as applied to claim 9 above, and further in view of Salmon et al (US5503155) as the latter was applied in the prior Office action.

Claims 14 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drost et al in view of Chandler et al as applied to claim 13 above, and further in view of McLeod et al (US4142412), as the latter was applied in the prior Office action.

Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drost et al as applied to claim1 above, and further in view of Boykin et al (US5360406) as the latter was applied in the prior Office action including note therein that the reference combination is applicable to claim 25 as dependent from claim 2 regarding the cannula feature whose obviousness had been argued therein. .

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drost et al in view of Chandler et al and Yock et al as applied to claim 33 above, and further in view of Gade as the latter was applied against claim 4 and in the prior Office action.

Claims 41 – 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drost et al in view of Chandler et al and Yock et al as applied to claim 40 above, and further in view of Salmon et al as the latter was applied against claims 10-12 and in the prior Office action.

Claims 45-46 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Drost et al in view of Chandler et al and Yock et al as applied to claim 44 above, and further in view of McLeod et al as the latter was applied against claims 14-15 above and in the prior Office action.

Allowable Subject Matter

Claims 16 – 18 and 20 – 23 are allowed.

Response to Amendment Remarks

Applicants' arguments that Drost et al does not teach an extension of the shapeable portion towards the handle nor does it necessarily pertain to a device adapted for insertion into the natural spaces of the brain is not well-taken since when combined with Chandler et al the latter makes clear that such an extension of shaping would make the offset stem pattern rigidly expressed in Chandler et al to be customizable to the natural variation between patients such that better device performance would be expected. Additionally Chandler et al amply discusses in col. 9 line 37 – col. 10 line 13 the desiderata of probe thinness versus application considerations. Arguments regarding the remaining dependent claims' features largely transfer intact from the prior Office action since Chandler et al merely supports a sizing and stem extension malleability for the device.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Jaworski Francis J. at telephone number 703-308-3061.



Francis J. Jaworski
Primary Examiner

FJJ:fjj

10-17-2004